

REMARKS/ARGUMENTS

Claims 1-22 are pending in the present application. Claim 19 was canceled; and claims 1, 7, 8, 14, 15, 21, and 22 were amended. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 101: Claims 15-21

The Examiner rejected claims 15-21 under 35 U.S.C. § 101 as directed towards non-statutory subject matter. Claim 15 has been amended accordingly, thus overcoming the rejection. Support for the claim amendments can be found on page 20 of the Specification.

II. 35 U.S.C. § 102, Anticipation: Claims 1-4, 7, 8-11, 14, 15-18, 21 and 22

The Examiner rejected claims 1-4, 7, 8-11, 14, 15-18, 21 and 22 under 35 U.S.C. § 102 as anticipated by *Easter et al.*, Method and System for Compliance Forms and Compliance Forms User Interface, U.S. Patent Publication No. 2004/0073868 A1 (April 15, 2004) (hereinafter "*Easter*"). This rejection is respectfully traversed.

With regard to claim 1, the Examiner states:

As per claim 1, *Easter* teaches a method in a data processing system for presenting input fields from a document, the method comprising:

Identifying a selected indicator associated with a set of mandatory input fields in the document; (see *Easter*, paragraph 0124) and

Presenting only the set of mandatory input fields. (see *Easter*, paragraph 0124; Since each field's visibility is controlled, the users can set non-mandatory fields to invisible)

Office Action dated February 9, 2007, pp. 2-3.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

Support for the amendment to claim 1 can be found on page 12 of the specification. Claim 1, as amended, is as follows:

1. A method in a data processing system for presenting input fields from a document, the method comprising:
parsing the document to identify a selected indicator associated with a set of mandatory input fields in the document and presenting only the set of mandatory input fields.

Claim 1 is not anticipated by *Easter* because *Easter* fails to teach the amended claim feature “*parsing the document to identify a selected indicator associated with a set of mandatory input fields*”. The amended claim language can be found on page 12 of the application as filed.

Easter teaches interactive and automated forms for use in filling out or otherwise performing functions requiring strict compliance to the forms. Depending on how a user fills out one field entry or section of a form, various other fields of the form can be presented or remain hidden. The forms and each of the various fields therein are known and interdependent on one another, such that no parsing is necessary to determine the mandatory input fields. As stated in *Easter*:

[I]nitially, a user accesses the GUI, including, for example, logging in or otherwise passing a security check 20. The user selects record identifier information or otherwise identifies a record, such as by inputting search criteria 21, and the user then selects from the search results or begins a new record (e.g., form) for input or revision 22.

Once the record is accessed, the user selects activities to be performed (e.g., selecting a meeting event for which to provide information) 23. Appropriate documents (e.g., forms) for the selected activity are identified and presented to the user with status indication (e.g., the user identifies a form type for access) 24. The user then selects the document to access and begins data entry or revision 25. The document may be automatically populated with data from an accessed repository, such as a repository for data for the present invention or maintained in other systems operating in conjunction with the present invention.

Easter, paragraphs 51-52.

Thus, again, *Easter* does not teach the deficiencies of amended claim 1. *Easter* fails to teach “*parsing the document to identify a selected indicator associated with a set of mandatory input fields*”. In light of the amendment, the rejection of claim 1 has been overcome.

Because claims 2-4 depend from claim 1, the same distinctions between *Easter* and the claimed invention in claim 1 applies to these dependent claims. Consequently, the rejection of claims 2-4 has been overcome.

Independent claims 8, 15 and 20 have been amended consistent with the amendments to claim 1. *Easter* does not anticipate claims 8, 15 and 20 as amended because *Easter* does not teach the claimed feature of “*parsing the document to identify a selected indicator associated with a set of mandatory input fields*”. Therefore, the rejection of claims 8, 15 and 20 under 35 U.S.C. § 102 has been overcome.

Claims 9-11 and 14 depend from claim 8. Claims 16-18 and 21 depend from claim 15. Therefore, the same distinctions between *Easter* and claims 8 and 15 apply to the respective dependent claims. Consequently, the rejection of claims 9-11, 14, 16-18 and 21 has been overcome.

III. 35 U.S.C. § 103, Obviousness: Claims 5, 6, 12, 13, 19 and 20

The Examiner has rejected claims 5, 6, 12, 13, 19 and 20 under 35 U.S.C. § 103 as being unpatentable over *Easter* in view of *Philippe et al.*, Method and System for Integrating Transaction Mechanisms Over Multiple Internet Sites, U.S. Patent No. 6,882,981 (April 19, 2005) (hereinafter "*Philippe*"). This rejection is respectfully traversed.

III.A. *Easter* and *Philippe* Do Not Teach Every Claim Feature

III.A.1. Claims 5, 12 and 19

With regard to claim 5, the Examiner states:

As per claim 5, *Easter* teaches the method of claim 1. However, *Easter* fails to teach the indicator is a hypertext markup language tag.

Philippe teaches the indicator is a hypertext markup language tag. (see *Philippe*; column 5, lines 20-40)

It would have been obvious to an artisan at the time of the invention to include *Philippe*'s teaching with method of *Easter* in order to allow users to fill out the application over the internet.

Office Action dated February 9, 2007, pp. 4.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Früch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). For an invention to be *prima facie* obvious, the prior art must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In the case at hand, the cited references when considered as a whole do not teach or suggest all of the limitations of the claims, arranged as they are in the claims.

The Examiner failed to state a *prima facie* obviousness rejection because neither *Easter* nor *Philippe* teach or suggest all features of claim 5. The Examiner admits that *Easter* does not teach the claimed features of, "identifying a selected indicator associated with a set of mandatory input fields in the document... wherein the indicator is a hypertext markup language tag." Contrary to the Examiner's assertion, *Philippe* teaches:

[A] method for interacting with multiple web sites in order to effect commercial transactions on the web. Systems according to the present invention enable online shoppers to make selections and purchase products from a plurality of vendor sources using a common interface program.

Philippe, col. 3, ll. 25-30.

Philippe does not teach the claimed feature of claim 5. In support of the rejection, the Examiner cites:

FIG. 1B is a functional diagram of the computer system of FIG. 1A. FIG. 1B depicts a server 20, and a representative client 25 of a multiplicity of clients which may interact with the server 20 via the internet 45 or any other communications method. Blocks to the right of the server are indicative of the processing components and functions which occur in the server's program and data storage indicated by block 35a in FIG. 1A. A TCP/IP "stack" 44 works in conjunction with Operating System 42 to communicate with processes over a network or serial connection attaching Server 20 to internet 45. Web server software 46 executes concurrently and cooperatively with other processes in server 20 to make data objects 50 and 51 available to requesting clients. A Common Gateway Interface (CGI) script 55 enables information from user clients to be acted upon by web server 46, or other processes within server 20. Responses to client queries may be returned to the clients in the form of a Hypertext Markup Language (HTML) document outputs which are then communicated via internet 45 back to the user.

Philippe, col. 3, ll. 25-30.

The only statement concerning HTML in the entirety of *Philippe* is this generic teaching that output to a user is generated in HTML. Thus, the cited portion of *Philippe* teaches only that results from *Philippe*'s multi-merchant buying procedure can be communicated to the user through the use of a web page. Nothing in the cited language teaches or suggests to one of ordinary skill in the art the claimed features of claim 1.

Thus, again, *Philippe* does not teach or suggest the acknowledged deficiencies of *Easter*. *Easter* in view of *Philippe* fail to teach or suggest "identifying a selected indicator associated with a set of mandatory input fields in the document... wherein the indicator is a hypertext markup language tag" as required by claim 5. For this reason, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Therefore, the rejection of claim 5 has been overcome.

Claims 12 and 19 are drawn to corresponding embodiments reciting features similar to those of claim 5. Thus, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) against claims 12 and 19. Therefore, the rejection of claim 12 and 19 has been overcome.

Additionally, claims 5, 12, and 19 depend from claims 1, 8, and 15 respectively. The same distinctions between *Easter* and claims 1, 8 and 15 apply to the respective dependent claims. *Philippe*

does not teach or suggest the acknowledged deficiencies of *Easter*. *Easter* in view of *Philippe* fail to teach or suggest “*parsing the document to identify a selected indicator associated with a set of mandatory input fields*,” as required by amended claims 1, 8, and 15. Therefore, by virtue of their dependence from otherwise allowable independent claims, the rejection of claims 5, 12, and 19 under 35 U.S.C. § 103(a) has been overcome.

III.A.2. Claims 6, 13 and 20

Claims 6, 13 and 20 depend from claims 1, 8, and 15 respectively. The same distinctions between *Easter* and claims 1, 8 and 15 apply to the respective dependent claims. *Philippe* does not teach or suggest the acknowledged deficiencies of *Easter*. *Easter* in view of *Philippe* fail to teach or suggest “*parsing the document to identify a selected indicator associated with a set of mandatory input fields*” as required by amended claims 1, 8, and 15. Therefore, by virtue of their dependence from otherwise allowable independent claims, the rejection of claims 6, 13 and 20 under 35 U.S.C. § 103(a) has been overcome.

III.B. No Motivation Exists to Combine *Easter* and *Philippe* Because They Address Different Problems

One of ordinary skill would not combine the references to achieve the invention of claim 1 because the references are directed towards solving different problems. It is necessary to consider the reality of the circumstances--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979). In the case at hand, the cited references address distinct problems. Thus, no common sense reason exists to establish that one of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. Accordingly, no teaching, suggestion, or motivation exists to combine the references and the Examiner has failed to state a *prima facie* obviousness rejection of claim 1.

For example, *Easter* is directed to solving the problem of providing user-friendly automated forms to ensure compliance with legal or other requirements. For example, *Easter* provides that:

There is an unmet need in the art for methods and systems for tracking information, supporting compliance with regulatory and other requirements, expertly assisting with completing forms, developing code and code documentation therefor, and otherwise providing assistance in meeting requirements for the complex and sophisticated management schemes that institutions need to use in order to effectively and efficiently manage mandated individualized instructional paths, disciplinary/rehabilitative paths, or social

intervention paths for hundreds if not thousands of students, juveniles, etc., simultaneously, all with different start and end dates, and different internal individualized management requirements..

Easter, p. 1, paragraph 3.

On the other hand, *Philippe* is directed to the problem of effecting transactions across multiple vendors in an integrated environment. For example, *Philippe* provides as follows:

The user's selections are received from the user and mapped to selected set of vendors. When the user is finished, she invokes a check-out application to automatically fill in one or many order entry forms for each of the relevant vendors whose goods the user selected during the course of shopping. The check-out application uses common information, such as name, address and credit card number, previously provided by the user in order to fill in the order entry forms for each vendor without requiring the user to fill in these forms. Finally, the check-out application tracks confirmation numbers in a common information store.

Philippe, col. 2, ll. 47-57.

Based on the plain disclosures of the references themselves, the references address completely distinct problems that are unrelated to each other. The problem of ensuring compliance with legal or other requirements in the filling out of forms is completely distinct from the problem of effecting transactions across multiple vendors in an integrated environment.

Because the references address completely distinct problems, one of ordinary skill would have no reason to combine or otherwise modify the references to achieve the invention of claim 1. Thus, no proper teaching, suggestion, or motivation exists to combine the references in the manner suggested by the Examiner. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 5, now amended into claim 1, or any other claim in this grouping of claims.

IV. Conclusion

The subject application is patentable over *Easter* and *Philippe* and should now be in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

/Brandon G. Williams/

Brandon G. Williams
Reg. No. 48,844
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorney for Applicant